

R E M A R K S

After careful consideration of the outstanding FINAL Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is at this time respectfully requested.

The undersigned will consider the rejections chronologically as set forth beginning at page 2, paragraph 2 of the outstanding Office Action.

At page 2, paragraph 2 of the outstanding Office Action, the Examiner rejected claims 12-14 and 23-25 under 35 U.S.C. § 112, first paragraph, because of the recitation of "discontinuous line of perforations." All reference to "discontinuous" has been eliminated in the latter claims. It is noted for the record that the Examiner has not objected to the recitation of "continuous line of perforations" (claim 11) and, therefore, the objection to the latter group of claims undoubtedly involved the term "discontinuous." Since the latter term has been eliminated in these claims, this rejection is believed moot.

Claim 16 has also been rejected under 35 U.S.C. § 112, first paragraph because of the statement therein "that the minor opposing surface areas are permanently adhesively bonded to each other is not supported in the specification." The original specification at page 3, states that the paper product 1 "comprises two paper surfaces 2, 3 glued to one another by means of an adhesive." The exact language in claim 16 was, prior to this amendment, that the paper surfaces were "substantially permanently adhesively bonded to each other." It would appear from the last sentence on page 2 of the outstanding Office Action that the Examiner has ignored the word "substantially," but to the mind of the undersigned two surfaces which are "substantially permanently adhesively bonded to each other" are "glued to one another by means of an adhesive" (pages 1 and 3 of specification). Be that as it may, claim 10 has

been amended to remove the phrase -- substantially permanently -- and, hopefully, the latter will render this rejection moot.

Claims 28 through 38 are also rejected under 35 U.S.C. § 112, first paragraph because of a rather lengthy quoted portion of claim 18 which seemingly differs from like language of claim 10 by the recitation of "a plurality of pairs." Assuming the latter-quoted phrase is the problem, noting that "substantially permanently" has been eliminated in claim 28, the description of the embodiment of the invention in Figure 3 is clearly directed to "a plurality of pairs of first and second sheets." Two such "pairs" 1 are shown connected by rings 8 in Figure 3 and obviously each pair or paper product 1 is formed of the sheets 2, 3, the seeds 6, and the line of perforations 5.

The Examiner also objected to the statement "a line of perforations in said first and second paper sheets of each pair." Except for "of each pair," the same limitation appears in claim 10, and obviously the only objection is because of the phrase "of each pair." As was noted earlier, since there are two pair of paper products 1 illustrated in Figure 3 and described in the original specification and since each pair or paper product is formed of sheets 2, 3, there is indeed "a line of perforations in said first and second paper sheets of each pair," as originally disclosed in the specification. Therefore, the withdrawal of the Section 112 rejection of claims 28 through 32 would be most appreciated.

The Examiner rejected all of claims 10 through 32 under 35 U.S.C. § 112, second paragraph, because of alleged indefiniteness concerning the meaning of "the major and minor surface area portions." The latter limitations appear in independent claims 10 and 28, and to resolve these and all other objections, pertinent portions of the specification have been cancelled and more idiomatic English has been used to render the claims definite. For example, it should be

clear to the Examiner that the portion, area or section 4 which is shown removed in Figure 2 is a "minor" portion as compared to the remainder or "major" portion of the product 1. If earlier unclear, the substitute portions of the specification ought clarify the problem.

As to the last objection concerning claims 12 through 14 and 23 through 25, since the term "discontinuance" has been deleted throughout the claims, this objection is also considered moot.

In view of the foregoing, entry of the amendment to the specification is requested to not only clarify any issues which may be remaining, but also to provide proper antecedent basis for the claims of record. Once the latter has been accomplished, the Section 112, first and second paragraph rejections, are believed to be overcome, and the formal withdrawal thereof would be most appreciated.

The Examiner rejected claims 10, 11 and 16 "under 35 U.S.C. 102(a) as being anticipated by DE Patent No. 3834812 to Baumli." As was stated in Stoller v. Ford Motor Co., 18 USPQ 2d 1545, 1546; Richardson v. Suzuki Motor, Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920:

A prior art reference anticipates a claim, and thus invalidates it under 35 U.S.C. § 102, if that reference discloses each and every element of the claim.

In describing the Baumli patent, the Examiner specifically referenced Figures 5 and 6 and define the line of perforations 8 as separating or delineating a major portion 1 from a minor portion 7. The Examiner then states: A germinative seed - 6 housed between the minor opposing surface portions which can be subsequently planted absent adversely effecting damaging or destroying," etc. Needless to say, the claimed opposing surfaces of the minor opposing surface area portions are also recited as being "adhesively bonded to

each other," and therefore it is the "germinative seed housed between said minor opposing surface area portions" which are collectively planted, not poured out of an opening in the major portion 1, as in the Baumli patent. A translation of the latter beginning at column 2, line 28, is attached hereto, and it is obvious that seeds are merely poured out of the seed bag 1 which is then re-closed to contain the remaining contents therein. Subsequently, the bag of Figures 1 through 3 or 5 and 6 can be reopened with continuous resealing being afforded by folding back parts of the bag upon the strip of adhesive 4, as is best illustrated in Figures 3 and 6. Therefore, the patent to Baumli failed to anticipate claim 10 as originally presented or as now amended which removes any issue as to whether or not the germinative seed is planted by planting the minor opposing surface area portion. In view of the foregoing, the withdrawal of the rejection of claims 10, 11 and 16 is believed proper and would be most appreciated.

At the top of page 6 of the outstanding Office Action, the Examiner rejected claims 12 and 14 under 35 U.S.C. § 103(a) "as being unpatentable over Baumli as applied to claim 10 above, and further in view of U.S. Patent No. 6,146,731 to Tanoto." The latter patent was utilized for disclosing lines of perforations which are "discontinuous." However, as was noted earlier herein, the word "discontinuous" has been removed from all of the claims and, therefore, the Tanoto patent is of no consequence.

Claim 15 was rejected under Section 103(a) over Baumli and U.S. Patent No. 4,027,340 to Hadtke. The Examiner correctly noted that this patent discloses a continuous line of perforations 22 and/or 24 of a **face mask!** This patent has absolutely no value with respect to providing motivation, suggestion or a teaching for utilizing a continuous closed line of perforations in the seed

bag of Baumli. The selection and application of the Hadtke patent is based solely upon hindsight. As was stated in Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1597:

Among legal standards for determining scope and content of the prior art, for example, are: a prior patent must be considered in its entirety, *i.e.*, as a *whole*, including portions that would lead away from the invention in suit, *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents, *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); and a court should avoid hindsight, *W.L. Gore & Associates, Inc.*, 721 F.2d at 1553, 220 USPQ at 313.

Obviously, the admonition against a court utilizing hindsight is equally applicable to an Examiner utilizing hindsight. Based upon the foregoing, the withdrawal of the latter rejection and the allowance of claim 15 is respectfully requested.

Claims 16 and 22 were also rejected over the Baumli patent "in view of U.S. Patent No. 6,383,593 to Fabel." The secondary patent to Fabel is directed to a "multi-part label sheet for use with a non-impact printer, and more particularly, to a multi-part label sheet for producing delivery confirmation labels which may be used for United States Postal Surface mailings." (See column 1, lines 7 through 11.) Once again, the patent to Fabel has been selected and utilized only through hindsight and lacks motivation, suggestion or teaching with respect to the subject matter of claims 16 and 22. Hence, the withdrawal of this patent and the formal allowance of claims 16 and 22 would be most appreciated.

Claim 17 was also rejected under Section 103(a) over the same Baumli patent "and further in view of U.S. Patent No. 5,860,245 to Welch." Welch was utilized for its disclosure of a "decomposable" adhesive. Why would one utilize a decomposable adhesive in the Baumli seed bag when to do so the adhesive would decompose and all of the seed would discharge therefrom rendering the seed bag and all components thereof inoperative for their intended purposes. Using decomposable adhesive in no way would make "the paper product more effective in promoting the plant seed to grow" because the paper product is not utilized in any fashion in the planting processes of either Baumli or Welch. With due respect, this is merely another example of the hindsight utilization and application of prior art. Accordingly, the withdrawal of the Welch patent and the formal allowance of claim 16 is respectfully requested.

In the rejection of claim 18 the Examiner utilized the patent to Baumli once again "and further in view of U.S. patent No. 4,168,002 to Crosby." The latter patent is said to disclose at column 3, lines 44 through 52 a means indicating the presence of the germinative seed between the minor opposing surface area portions 17 and 18. The Examiner is absolutely correct with respect to the Crosby patent which teaches providing each removable strip of seeds 13, 14, 15 "with a label to identify the seeds contained therein." The undersigned has absolutely no objection to the Examiner utilizing this teaching in the Baumli patent, but the same does not obviate the rejection of claim 10. Accordingly, claim 18 is directed to unobvious subject matter irrespective of the Crosby patent. However, the undersigned will note for the record that the seeds 19 in the Crosby patent are **poured out** of an opening during planting (Figure 4), just as they are **poured out** of the seed bag 1 of the Baumli patent.

Therefore, neither of these patents disclose a minor portion with a germinative seed housed therein which is planted.

The comments with respect to claim 18 are equally applicable to claim 19 inasmuch as the combination of Baumli and Tuhkanen (4,838,580) does not render claim 10 obvious, and thus claim 19 depending therefrom is likewise directed to unobvious subject matter.

As to the rejection for claim 20, the entirety of the Baumli disclosure does not render claim 10 obvious and, hence, claim 20 depending therefrom cannot be rendered obvious. Therefore, the allowance of claim 20 for the reasons advanced in the discussion of claim 10 would be most appreciated.

With respect to the rejection of claim 21 based upon Section 103(a), the utilization of the patent to Werjefelt (5,062,229) is yet another example of hindsight. Nothing, other than the present disclosure, suggests a new and unobvious calendar product in which individual major portions thereof identify a calendar field. Absent some reasoned analysis which is presently absent from this record, the withdrawal of the rejection of claim 21 and the allowance thereof would be most appreciated.

As to the remaining rejections of the claims depending directly or indirectly from claim 10, the arguments heretofore presented are incorporated hereat by reference in order not to unduly lengthen this record. However, it is re-emphasized that the subject matter of claim 10 finds no counterpart in any combination of the prior art, particularly since the Baumli patent is nothing more than a seed bag 1 from which seeds are poured when the seed bag 1 is torn along any of the lines of perforation 3, 7. Barring pertinent prior art which is suggestive of the invention of claim 10 or renders the same obvious, the

formal allowance of claim 10 and all of the claims depending therefrom is clearly apparent and is respectfully requested.

Turning to independent claim 28 and the rejection thereof, as well as the rejections of the claims depending therefrom, the patent to Baumli does not disclose the “paper product” defined in independent claim 28 or any of the claims depending therefrom. Claim 28 includes the identical limitations as appear in claim 10, but the paper product of claim 10 is defined in “a plurality of pairs” thereof. Since the Examiner has failed to render obvious the “paper product” of claim 10, the same prior art cannot render obvious the “plurality of pairs” of such paper product as recited in claim 28. This alone is reason enough for withdrawing the rejection of claim 28 and allowing this claim and the claims depending therefrom.

However, the Examiner has again utilized the patent to Werjefelt (5,062,229) in the rejection of claim 28 because “Baumli does not disclose a plurality of pairs of first and second paper sheets.” The Examiner finds in the Werjefelt patent “means for defining a calendar field -30 - see figures 1-2.” Most certainly, the postcard calendar R of Werjefelt discloses a “demarcation or perforated line 22 (which) runs across each of the sheets 2 for dividing each sheet into an upper portion 24 and a lower portion 26.” Under the caption OPERATION, “a user can separate the lower portion 26 of the front cover sheet 18,” etc. so that the calendar indica of the upper portion “will now be visible.” As time goes on during the year, “the user can tear off the postcard lower portions 26 until they have all been used up. The upper portion 24 bearing the calendar indicia 30 will simply remain affixed through the binders 5 and 6, ready to be turned over when it expires.” Absent hindsight, what has this patent to do with the Baumli disclosure? Where did any suggestion or motiva-

tion originate for selecting and utilizing this "teaching" with that of the Baumli patent? Apart from the fact that Baumli per se does not render obvious the subject matter of claim 10 and thus claim 28, the hindsight application of the Werjefelt disclosure renders the rejection of claim 28, as well as the claims depending therefrom untenable and erroneous. Hence, the withdrawal of the latter rejection would be most appreciated.

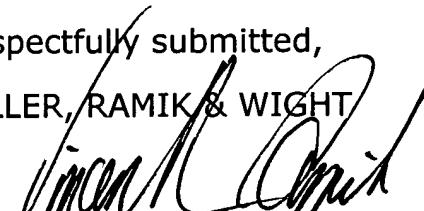
In view of the foregoing, the entry of this amendment and the formal allowance of all of the claims of record would be most appreciated.

In the event the Examiner intends to anything other than entering this amendment and allowing all of the claims of record, he is respectfully requested to telephone the undersigned in order that a personal interview can be arranged. The undersigned will accommodate the Examiner's scheduling.

Respectfully submitted,

DILLER, RAMIK & WIGHT

By:


Vincent L. Ramik, Reg. 20,663

7345 McWhorter Place; Suite 101
Annandale, Virginia 22003
(703) 642-5705 - phone
(703) 642-2117 - fax

Attachments: Marked up claims
 New pages 3 and 4 of specification
 A translation of Baumli patent, beginning at column 2, line 28

Marked-Up Claims
D'Agnone 09/892,486 of 6/28/01



RECEIVED
NOV 15 2002
GROUP 3600

Claims 10, 12 through 14, 16, 23 through 25 and 28, amended as follows:

10. (Amended) A paper product comprising first and second paper sheets each having first and second opposite paper surfaces with said first paper surfaces being in substantially planar contiguous surface-to-surface opposing relationship at both major and minor opposing surface area portions thereof, said major opposing surface area portions of said first and second paper sheets first paper surfaces being [substantially permanently] adhesively bonded to each other, a line of perforations in said first and second paper sheets which is adapted to be torn to facilitate the separation of said major and minor opposing surface area portions from each other, and a germinative seed housed between said minor opposing surface area portions which minor opposing surface area portions and the germinative seed housed therein can be subsequently planted absent adversely affecting, damaging or destroying the major opposing surface area portions.
12. (Amended) The paper product as defined in claim 10 wherein said line of perforations [is a substantially discontinuous line of perforations] has opposite ends.

13. (Amended) The paper product as defined in claim 10 wherein said line of perforations [is a substantially discontinuous line of perforations extending] extend substantially between edges of said sheets.
14. (Amended) The paper product as defined in claim 10 wherein said line of perforations [is a substantially discontinuous line of perforations extending] extend substantially between opposite edges of said sheets.
16. (Amended) The paper product as defined in claim 10 wherein said minor opposing surface area portions of said first and second paper sheets first paper surfaces are [substantially permanently] adhesively bonded to each other.
23. (Amended) The paper product as defined in claim 16 wherein said line of perforations [is a substantially discontinuous line of perforations] has opposite ends.
24. (Amended) The paper product as defined in claim 16 wherein said line of perforations [is a substantially discontinuous line of perforations extending] extend substantially between edges of said sheets.
25. (Amended) The paper product as defined in claim 16 wherein said line of perforations [is a substantially discontinuous line of perforations extending] extend substantially between opposite edges of said sheets.

28. (Amended) A paper product comprising a plurality of pairs of first and second paper sheets each having first and second opposite paper surfaces with said first paper surfaces being in substantially planar contiguous surface-to-surface opposing relationship at both major and minor opposing surface area portions thereof, said major opposing surface area portions of said first and second paper sheets first paper surfaces of each pair being [substantially permanently] adhesively bonded to each other, a line of perforations in said first and second paper sheets of each pair which is adapted to be torn to facilitate the separation of said major and minor opposing surface area portions from each other, a germinative seed housed between said minor opposing surface area portions of each pair which minor opposing surface area portions and the germinative seed housed therein can be subsequently planted absent adversely affecting, damaging or destroying the major opposing surface area portions, and means for connecting said pairs together.

Fig. 2 shows the paper product of Fig. 1 with separated section,
Fig. 3 shows a perspective view of a calendar according to the
invention, and
Fig. 4 shows a top view of a visiting card according to the invention.

DESCRIPTION OF THE PREFERRED EMBODIMENTS

A paper product 1 constructed in accordance with this invention comprises a first paper sheet 2 and a second paper sheet 3 each having first and second opposite paper surfaces (unnumbered) with the first paper surfaces of the first and second paper sheets 2, 3, respectively, being in substantially planar contiguous surface-to-surface opposing relationship. (For illustration purposes a triangular portion of the first paper sheet 2 is omitted in Figs. 1 and 2.) The two paper sheets 2, 3 are glued to one another by means of an adhesive (not shown) between the first surfaces of the first and second sheets 2, 3, respectively. Prior to being glued together a germinable seed-corn (not shown) is located between the first and second sheets 2, 3, respectively, in a section 4 defined within and by a discontinuous circular line of perforations 5. The line of perforations 5 defines therewithin minor opposing surface area portions of the first and second paper sheet first paper surfaces, and outboard of the line of perforations are major opposing surface area portions of the first and second paper sheets first paper surfaces. The line of perforations 5 is adapted to be torn (Fig. 2) to facilitate the separation of the minor opposing surface area portion, namely, the section 4 from the remaining major opposing surface area portion outboard thereof. The section 4 with the germinative seed housed between the minor opposing surface area portions thereof can then be subsequently planted absent adversely effecting, damaging or destroying the major opposing surface area portions.

Preferably the minor area, portion or section 4 is provided with an inscription or symbol 6 drawing attention to the seed-corn contained therein. Thus when the section 4 containing the germinable seed-corn has been separated, the latter is then easily planted and the major remaining portion of the paper product 1, outboard of the circular line of perforations 5, can be continually used as, for example, a book marker. Though the minor section or

portion 4 is shown of a circular or round configuration, the same may have any other geometric form.

Fig. 3 illustrates a perspective view of a calendar 7 constructed in accordance with this invention in which individual paper products 1 each constructed from first and second paper sheets 2, 3, respectively, adhesively bonded together at opposing surfaces are connected to each other via eye rings 8. In this embodiment of the invention, the section or portion 4 is of a rectangular configuration of the size of a postcard, and is easy to separate from a calendar leaf 9 along a line of perforations 5. In this embodiment of the invention, the seed-corn is designated by the reference numeral 6 and is located between opposing surfaces of the paper sheets 2, 3 of the section or portion 4 which preferably is configured as a postcard or a greeting card, though another smaller section, as shown in Fig. 1, may be provided.

Fig. 4 shows a paper product 1 substantially identical to that heretofore described with respect to Figs. 1 through 3 which is formed of two paper sheets 2, 3 glued to each other by an adhesive (not shown) with the paper product being configured as a visiting card. The section 4 contains a germinable seed-corn (not shown) and can be separated along a line of perforations 5 without an address field and the visiting card proper being damaged.

In further accordance with this invention, it is to be noted that the invention relates to various paper products, including packing material, catalogs and the like.

Although a preferred embodiment of the invention has been specifically illustrated and described herein, it is to be understood that minor variations may be made in the product without departing from the spirit and scope of the invention, as defined by the appended claims.

German Offenlegungsschrift [laid-open] DE 38 34 812 A1

Translated title: "Seed packet"

Applicant: Richard Geissler AG, Zürich, CH

KB/Dt

English translation of column 2, line 29 to column 3, line 11

The seed bag 1, closed on all sides and containing seeds 5, is suitably provided in the usual manner with information on the contents, the seed culture and - if desired- on the retail price, and is formed with a suspension opening 2 for suspended attachment to common sales racks for seeds. To facilitate the opening of the bag so as to sow its contents, a tear-open line 3 is provided in parallel to an edge and close to that edge. Applied in parallel to this tear-open line, substantially in the middle of the bag, is a strip-shaped adhesive layer 4. This adhesive layer 4 extends from one edge of the bag to the opposite edge of the bag and can be formed of a known adhesive for repeated adherence, or of a strip of commercially available adhesive band for two-sided adherence. The adhesive layer can be covered by a removable protective strip, not illustrated in greater detail in the drawing.

Further, on the surface of the seed bag - in the illustrated example, on the side facing away from the adhesive layer - a wooden label 5 is releasably attached, e.g. by means of an adhesive for repeated adherence. This label is suitably configured as a stick-in label with a pointed tip and is provided with a lettering indicating the name of the seeds contained in the bag.

For sowing the seeds packed in the bag, the bag will be opened by tearing off the strip 6 along the tear-open line 3, and the contents of the bag will be partially or wholly scattered onto the prepared culture substrate. If, as may happen occasionally, not the whole contents of the bag are used, the bag can be closed again in the most simple manner. For this purpose, it will be sufficient if the part of the bag comprising the pour-out opening is folded back in such a manner along a folding edge extending in parallel to the adhesive-layer strip that this folded-back part will cover the adhesive layer 4 which may have the protective strip arranged thereon, and to connect the folded-back part to the

2

adhesive layer 4 by slight pressing it onto the latter. Figs. 3 and 4 illustrate the bag which has been re-closed in this manner. In this fashion, the seeds still remaining in the bag cannot fall out and be lost even in case of further manipulations. The stick-in label 5 can then be detached from the bag and be stuck into the culture substrate in the sowing region.

If, at a later time, also the remaining contents of the seed bag 1 are to be sown, the bag can be reopened by detaching the folded-back part from the adhesive layer 4. For marking this further sowing region, the meanwhile empty seed bag can be stuck into the culture substrate.

German Offenlegungsschrift [laid-open] DE 38 34 812 A1

KB/Dt

Translated title: "Seed packet"

Applicant: Richard Geissler AG, Zürich, CH

English translation of the last paragraph of the description

A further advantageous embodiment is illustrated in Figs. 5 and 6. In this example, the adhesive layer 4 is arranged in the region of the corner 7 of the seed bag 1, at which corner there is also formed a prepared tear-open line 8. By tearing off the corner 7 along the tear-open line 8, an opening is generated for the dispensing of seed contained in the bag. For re-closing the thus opened bag 1, the corner portion is folded back about a folding edge 9 - which, if desired, is marked by printing on the bag - onto the adhesive layer 4 and is connected thereto.